



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/809,953      | 03/26/2004  | Herman Van Mellaert  | 021565-155          | 2781             |

21839 7590 10/18/2006

BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER

KUBELIK, ANNE R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1638

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|  |   |   |  |
|--|---|---|--|
| <p align="center"><b>Office Action Summary</b></p> | <p>Application No.</p> <p align="center">10/809,953</p> | <p>Applicant(s)</p> <p align="center">VAN MELLAERT ET AL.</p> |  |
|  | <p>Examiner</p> <p align="center">Anne R. Kubelik</p>   | <p>Art Unit</p> <p align="center">1638</p>                    |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-33 is/are pending in the application.
- 4a) Of the above claim(s) 20,23 and 28-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21,24,26 and 33 is/are rejected.
- 7) ☒ Claim(s) 22,25,27 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 20-33 are pending.

Claims 20, 23 and 28-31 are withdrawn from consideration, as being drawn to a non-elected invention.

2. This application contains claims 20, 23 and 28-31 are drawn to an invention nonelected with traverse in the response filed 17 November 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The abstract remains not descriptive of the instant invention, which is a DNA encoding a Bt14 protein, chimeric genes, plant, seeds and plant cells comprising it, and a method of using it to control insects. A new abstract is required that is clearly indicative of the invention to which the claims are directed. The abstract of the disclosure should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The abstract filed 27 July 2006 does not specify the Bt14 protein encoded by the claimed nucleic acid.

5. The terminal disclaimer filed on 27 July 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5,866,784, 6,172,281, and 6,855,873 has been reviewed and is accepted. The terminal disclaimer has been recorded.

6. The rejection of claim 32 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of controlling insects comprising growing plants or seeds transformed with a nucleic acid encoding a Bt14 endotoxin, does not reasonably provide enablement for a method of controlling insects comprising growing plant cells transformed with a nucleic acid encoding a Bt14 endotoxin is withdrawn in light of Applicant's amendment of the claim.

7. The rejection of claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Brizzard et al (1988, Nuc. Acids Res. 16:4168-4169) is withdrawn in light of Applicant's amendment of the claims.

8. The rejection of claims 21, 24 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Rangan (US Patent 5,244,802, filed November 1987) is withdrawn in light of Applicant's amendment of the claims.

9. The rejection of claims 21-22, 24-27 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 22 of U.S. Patent No. 6,172,281 is withdrawn in light of Applicant's filing a terminal disclaimer.

10. The rejection of claims 21-22, 24-27 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-15 of U.S. Patent No. 5,866,784 is withdrawn in light of Applicant's filing a terminal disclaimer.

11. The rejection of claims 21-22, 24-27 and 32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,855,873 is withdrawn in light of Applicant's filing a terminal disclaimer.

***Claim Rejections - 35 USC § 112***

12. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections. The rejection is different from the rejection set forth in the Office action mailed 2 February 2006, as applied to claims 21-22, 24-25 and 32. Applicant's arguments filed 27 July 2006 have been fully considered but they do not apply to this new rejection.

Claim 33 is indefinite for reciting a method without reciting what the method is intended to do or produce.

***Double Patenting***

13. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

14. Claims 21, 24 and 26 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 3-4 of prior U.S. Patent No. 6,855,873. This is a double patenting rejection.

Art Unit: 1638

15. Claims 22, 25, 27 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The central fax number for official correspondence is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

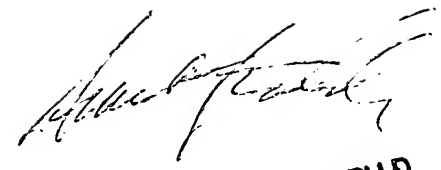
Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Application/Control Number: 10/809,953  
Art Unit: 1638

Page 6

Anne Kubelik, Ph.D.  
October 5, 2006

A handwritten signature in black ink, appearing to read 'Anne Kubelik', written in a cursive style.

**ANNE KUBELIK, PH.D.  
PRIMARY EXAMINER**